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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,190	12/22/2000	Timo Kinnunen	367.39429X00	8071

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EXAMINER

HASHEM, LISA

ART UNIT PAPER NUMBER

2645

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,190

Applicant(s)

KINNUNEN ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 4 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-22 are pending in this office action.

Information Disclosure Statement

2. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 2, is attached to the instant office action.

Drawings

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on accepted have been October 15, 2003.

Claim Objections

4. Claim 4 (page 8, lines 18-19) is objected to because of the following informalities: It is unclear whether claim 4 is dependent on claim 3 or claim 1. Examiner assumes claim 4 is dependent on claim 3. Appropriate correction is required.

5. Claim 20 (page 10, lines 10-11) is objected to because of the following informalities: The sentence is incomplete; a 'period' should be put at the end of the sentence instead of a 'comma'. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 recites the limitation "said further device" in claim 21 (page 10, lines 20 & 22).

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 15-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 6,421,707 by Miller et al.

Regarding claim 15, a method of creating a message via email on a communications device (see Figure 4b); comprising selecting a component (Figure 4b, WDS-1-14-98.ppt; column 4, lines 33-34) from a source (Figure 4b, E:\temp\) and defining a set of conditions for delivery of the message (column 4, lines 54-61).

Regarding claim 16, a method as claimed in Claim 15, wherein the conditions include data relating to a time of delivery of the message (column 4, lines 59-61).

Regarding claim 17, a method as claimed in Claim 15, wherein the conditions include data relating to a location, e.g. Thomas's handset, for delivery of the message (column 4, lines 56-57).

Regarding claim 18, a method as claimed in Claim 17, wherein the location is defined by a geographical location via Global System for Mobile Communication (GSM) (column 3, lines 57-61).

Regarding claim 19, a method as claimed in Claim 17, wherein the location is defined by the presence of a further device, e.g. a service controller (column 9: lines 26-28, 51-58).

Regarding claim 20, a method as claimed in Claim 15, including the step of creating a

presentation file or PowerPoint file inherently on sender's communications device (as shown in Figure 4b) associated with said component (Figure 4b, WDS-1-14-98.ppt; column 4, lines 33-34).

Regarding claim 21, a method of opening a message on a communications device the message having first been created in accordance with the method of Claim 15, comprising receiving the message (Figure 4f), storing the message in the communication device (column 5, lines 15-16), analyzing the delivery conditions (Figure 4g), and in the event that they are met opening the message (Figure 4h).

Regarding claim 22, a method as claimed in Claim 21, including the further step of establishing a communications channel with said device (column 9: lines 37-46, 51-68) and subsequently opening at least a portion of said message on said device (column 5, lines 50-56).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 6,421,707 by Miller et al in view of U.S. Patent No. 6,108,688 by Nielsen.

Regarding claim 1, Miller et al disclose a communications device (Figure 1, 120) including a messaging user interface (Figure 1, 122; column 3, lines 6-15), the interface including means for selecting a component for inclusion in a message (as shown in Figure 1, 150; column 2, lines 65-66), means for selecting the conditions under which the message may be

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opened (Figure 1, 110; column 2, line 66 – column 3: line 5) and means for storing said component as a message (column 3, lines 16-26) and the message is associated with a message header holding message delivery conditions (see Figure 4g, 412).

Miller et al do not teach means for storing said component as a message together with a message header holding the message delivery conditions in a memory of the communication device.

Nielsen teaches a communications device (column 2, lines 61-62) including a messaging user interface (Figure 2, 25), the interface including means for selecting a component for inclusion in a message (column 3, lines 64-67); means for selecting the conditions under which the message may be opened (column 3, lines 49-51) and means for storing said component (Figure 1, 18) as a message together with a message header holding the message delivery conditions (Figure 1) in a database of the communication device (column 3, lines 36-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Miller et al to include means for storing said component as a message together with a message header holding the message delivery conditions in a database of the communication device as taught by Nielsen to provide storage of the delivery information along with the message. One of ordinary skill in the art would have been lead to make such a modification since a sender can specify a date and time by which the message should be opened by the recipient and the delivery information and the message is included in a message header which is stored in a database of said device in order for the sender to monitor the status of said message.

Regarding claim 2, a device as mentioned in Claim 1 above, in which Miller et al further inherently disclose the message header further contains information descriptive of the content of the multimedia message as shown in (Figure 4i, 412).

Regarding claim 3, a device as mentioned in Claim 1 above, wherein Miller et al further disclose entries of locations from which components are selectable (Figure 4a, 401; Figure 4b: E:\temp\wdsatt.txt, E:\temp\WDS-1-14-98.ppt, C:\1386\Ringout.wav -> these components were selected from different locations on the user's system; column 4, lines 29-40).

Miller et al do not teach a look-up table wherein the table contains entries of locations from which components are selectable.

Nielsen teaches a look-up table (Figure 2, 40) wherein the table contains entries of recipients from which a warning is selectable so the sender can select whether a response from that recipient is necessary prior to the date and time the sender has designated (Figure 2, 30; column 4, lines 53-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Miller et al to include a look-up table wherein the table contains entries as taught by Nielsen to assist the user in sending a recipient a component in a message. One of ordinary skill in the art would have been lead to make such a modification since a look-up table would allow the user to easily search for entries of locations from which components are selectable rather than using the inherent method of attaching a file to search for the particular component on the user's system. Also, the search criteria in the table can be designated for 'locations' rather than 'recipients' and a 'component' can be selected in the checkbox rather than a 'warning'.

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Regarding claim 4, a device as mentioned in Claim 3 above, wherein Nielsen further discloses at least one of the locations or 'recipients' in the table are an entry in the database of the communication device (column 4, lines 1-4).

Regarding claim 5, a device as mentioned in Claim 1 above, wherein Miller et al further disclose the message includes a plurality of components and associated presentation files (Figure 4b: E:\temp\wdsatt.txt, E:\temp\WDS-1-14-98.ppt, C:\1386\Ringout.wav; column 4, lines 29-40).

Regarding claim 6, a device as mentioned in Claim 1 above, wherein Miller et al further disclose at least one component is a multimedia file (Figure 4b; C:\1386\Ringout.wav; column 4, lines 29-40).

Regarding claim 7, a device as mentioned in Claim 1 above, wherein Miller et al further disclose a means for creating a presentation file associated with said component, said file being stored with said message (please see rejection for the method in claim 20 above for the rejection of the device in claim 7).

Regarding claim 8, a device as mentioned in Claim 7 above, wherein Miller et al further disclose the presentation file may inherently contain parameters relating to the size and position or URL address of a component comprising a video image. These parameters in the presentation file can be verified on the sender's computer terminal before sending the file to the recipient.

Regarding claim 9, a device as mentioned in Claim 7 above, wherein Miller et al further disclose the presentation file contains parameters relating to the volume of a component comprising an audio recording, inherently the sender can verify the volume of the component in the presentation file on the sender's computer terminal.

Regarding claim 10, a device as mentioned in Claim 7 above, wherein Miller et al further disclose the presentation file contains parameters relating to the color and font of a component comprising a text string (as shown in Figure 4b: the buttons relating to the color and font of the text, these same buttons would be included in creating the presentation file).

Regarding claim 11, a device as mentioned in Claim 1 above, wherein Miller et al further disclose a means for formatting the message as an attachment to a short text message (as shown in Figure 4b).

Regarding claim 12, a device as mentioned in Claim 1 above, wherein Miller et al further disclose a means for formatting the message as an email (as shown in Figure 4a).

Regarding claims 13 and 14, a device as mentioned in Claim 1 above, wherein Miller et al further disclose a network interface means (as shown in Figure 4b) and the device is a computer terminal.

Miller et al do not disclose a wireless network interface means and the device is a radio telephone.

Miller et al teach a communications device or cellular/PCS telephone (Figure 3, 301) using GSM as a carrier network (Figure 3; column 3, lines 59-61) including a wireless network interface (Figure 4n, 412).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the computer terminal of Miller et al to include a wireless network interface means and the communication device being a radio telephone as taught by the mobile handset of Miller et al to provide a handset with an improved user interface. One of ordinary skill in the art would have been lead to make such a modification since the communication device being a

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cellular/PCS telephone can utilize a wireless network interface to send a multimedia message to an equipped device such as a fax to display the message.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,175,743 by Alperovich et al teach a method for encapsulating header information associated with a SMS message; the header information includes message delivery conditions

12. Any response to this action should be mailed to:

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or

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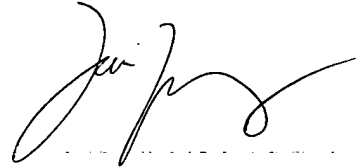
relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

October 17, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written over a horizontal dashed line.